

Commissioner of Patents
Serial No. 10/757,290
February 12, 2007
Reply to Office Action dated August 10, 2006
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REMARKS

I. Status of the Application.

Claims 1-27 were pending in the above-referenced patent application as filed. In an Office Action dated March 3, 2006, the Examiner required that the Applicants elect a single disclosed species for prosecution on the merits in the event that no generic claim is held to be allowable. The Examiner identified Claims 1, 19, and 27 as generic claims and identified the following species and subspecies: Species X characterized by a bucking coil, Species Y characterized by a spider web coil, Subspecies A characterized by four or more turns in the inner spiral tube, and Subspecies B characterized by a prime number of turns in the inner spiral tube.

In a response dated May 1, 2006, the Applicants respectfully traversed the requirement and provisionally elected Species X and Subspecies A.

In the Office Action, the Examiner has removed the requirement for the election between Subspecies A and B, and indicated that claims 21-23, 25, and 26 were withdrawn. The Examiner also rejected Claims 1-20, 24, and 27 under 35 U.S.C. § 101, as allegedly being inoperative and therefore lacking utility.

In this response, Applicants respectfully traverse the Examiner's rejections.

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II. The Rejection of Claims 1-20, 24, and 27 Under 35 U.S.C. §101 As Lacking Patentable Utility Should Be Withdrawn.

A. The Examiner Acknowledged the Well-Established Utility of the Claimed Invention in Previous Official Correspondence.

Claims 1-20, 24, and 27 are drawn only to bulb apparatuses of various structures. Such bulb apparatuses are patentable subject matter under 35 U.S.C. § 101. Indeed, the Examiner acknowledged the well-established utility of such apparatuses in his correspondence dated March 3, 2006: "In the instant case the bulb can be used simply as a light source." (March 3, 2006, Office Action, p. 3).

"If an invention has well-established utility [a] rejection[] under 35 U.S.C. § 101 . . . based on lack of utility should not be imposed." *In re Folkers*, 344 F.2d 970 (C.C.P.A. 1965); MPEP § 2107.02. Accordingly, it is respectfully submitted that the Examiner has acknowledged the well-established utility of the apparatuses claimed by the Applicants in Claims 1-20, 24, and 27. Thus, it is respectfully submitted that the rejections of Claims 1-20, 24, and 27 under 35 U.S.C. § 101 should be withdrawn.

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B. The Examiner Has Failed to Show a Prima Facie Acknowledged the Well-Established Utility of the Claimed Invention in Previous Official Correspondence.

Although Section II.A hereof clearly establishes that the rejections of Claims 1-20, 24, and 27 under 35 U.S.C. § 101 should be withdrawn, the Applicants also wish to submit the following remarks. The following remarks should be considered as supplemental to the remarks contained in Section II.A.

Applicants respectfully submit that the rejections of Claims 1-20, 24, and 27 under 35 U.S.C. § 101 are improper and should be withdrawn, because the Examiner has not made a *prima facie* showing that the inventions claimed in Claims 1-20, 24, and 27 lack utility. "To properly reject a claimed invention under 35 U.S.C. 101, the Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing." MPEP § 2107.02 IV (citing *In re Gaubert*, 524 F.2d 1222 (CCPA 1975) ("Accordingly, the PTO must do more than merely question operability - it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability.")).

To make a proper *prima facie* showing of showing that a claimed invention lacks utility, an examiner must provide: (i) an explanation that clearly sets forth the reasoning why the examiner concluded that the claimed invention does not set forth a specific and substantial or well-established utility; (ii) the factual findings and support for such findings that support the conclusion; and (iii) an evaluation of all relevant evidence of record and the utilities taught in the closest prior art. MPEP § 2107.02 IV.

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Applicants respectfully submit that the Examiner failed to develop a *prima facie* case that the bulb apparatuses claimed in Claims 1-20, 24, and 27 lack utility. The Examiner does not provide an explanation that clearly sets forth the reasoning why the Examiner came to this conclusion, and did not set forth sufficient factual findings to support the conclusion with respect to the apparatuses claimed by Applicants in Claims 1-20, 24, and 27. Finally, the Examiner does not provide an evaluation of all relevant evidence of record and the utilities taught in the closest prior art.

The Examiner attempts to establish a *prima facie* case by reciting examples of why certain methods of using the apparatuses claimed by Applicants in Claims 1-20, 24, and 27 may lack patentable utility. For example, the Examiner asserts that using the "photons emitted from the presently claimed bulb assembly . . . to irradiate a patient's body and deliver 'the beneficial quantum information of the medicine or other substance directly to the patient's cells,' . . . is an inoperative utility." (Office Action, p. 3). However, no methods claims are pending.

For the foregoing reasons, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case that the apparatuses claimed by the Applicants in Claims 1-20, 24, and 27 lack utility. Thus, it is respectfully submitted that the rejections of Claims 1-20, 24, and 27 under 35 U.S.C. § 101 should be withdrawn.

C. The Applicants have Asserted Specific and Substantial Utility.

Although Sections II.A-B hereof clearly establishes that the rejections of Claims 1-20, 24, and 27 under 35 U.S.C. § 101 should be withdrawn, the Applicants also wish to submit the

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following remarks. The following remarks should be considered as supplemental to the remarks contained in Section II.A-B.

Even if the Examiner has established a *prima facie* case that the apparatuses claimed by the Applicants in Claims 1-20, 24, and 27 lack utility, the Applicants respectfully state that the Applicants have asserted a specific and substantial utility sufficient to overcome any *prima facie* case that the apparatuses claimed by the Applicants in Claims 1-20, 24, and 27 lack utility.

Applicants respectfully direct the Examiner's attention to the passage of the present application beginning at line 22 of page 14, and concluding at line 2 of page 17. According to this passage, a material is caused to flow through the disclosed bulb assembly, an RF signal is transmitted through coil of the disclosed bulb assembly, and a pulsed DC signal is introduced into the internal cavity of the disclosed bulb assembly, emitting visible and invisible photons.

Accordingly, it is respectfully submitted that the Applicants have asserted a specific and substantial utility of the apparatuses claimed by the Applicants in Claims 1-20, 24, and 27. Thus, it is respectfully submitted that the rejections of Claims 1-20, 24, and 27 under 35 U.S.C. § 101 should be withdrawn.

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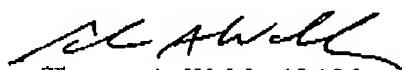
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CONCLUSION

For all of the foregoing reasons, it is respectfully submitted that Applicants have made a patentable contribution to the art. Favorable reconsideration and allowance of this Application is therefore respectfully requested. In the event Applicants have inadvertently overlooked the need for payment of an additional fee, Applicants conditionally petition therefore, and authorize any deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

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